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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,989	02/02/1999	MASARU SUZUKI	JA992-011-(8	9403

7590

05/09/2002

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SUITE 501
EAST MEADOW, NY 11554

EXAMINER

PARKER, KENNETH

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.
09/241,989

Applicant(s)
Suzuki et al

Examiner
Kenneth Parker

Art Unit
2871



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 9, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15-20, 22-24, 28, 29, 31, 32, and 35-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15-20, 22-24, 28, 29, 31, 32, and 35-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 2871

DETAILED ACTION

Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5600462, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Response to Amendment

1. **The amendment filed 11/30/1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.** 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: .

The description of and reference to pitch variations in the prims. This is not a request to change the drawings- the drawings do not indicate multiple pitches, but a single pitch that can be set to anywhere from a lower to a higher level. What needs to be removed is any reference to multiple pitches, something that was not previously a part of the application.

Applicant is required to cancel the new matter in the reply to this Office action.

Art Unit: 2871

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 28-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.** The figure that shows “pitch=150+-10um” still shows a single pitch, not multiple pitches between peaks. Those of ordinary skill would construe this as it is stated- that the pitch (a single pitch) should be set at 150 plus or minus 10 um, not that there should be different pitches from prism to prism. The language does not exclude the possibility of variations, however it does not provide description of variations in pitch from prism to prism.

3. **Claims 28-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.** Applicant has given no indication of how or why the pitch should be varied. Although one could make pitches that vary, without known why they are doing it, or how

Art Unit: 2871

it should be done, they would not be able to make a variation which is one which is the subject of the invention.

Declaration

4. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Amendments A,B and C were filed after all reissue declarations of record; thus the changes made therein do not appear to be covered by any reissue declaration of record. A supplemental reissue declaration is required.

5. Claims 8-42 are rejected as being based upon a defective oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Art Unit: 2871

Reissue Applications

6. Claims 8-9 and 11-42 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The discussion of the recapture issue is as presented in the office action of paper # 8.

Response to Arguments

Applicant's arguments filed regarding the recapture have been fully considered but they are not persuasive. Applicant's argument appears to be incorrect as applicant, as it

Art Unit: 2871

appears that applicant had explicitly argued the benefits of the 95 degree angle at the time of amendment. Additionally, the secondary reference, Ooi et al, taught a range of up to 90 degrees.

Applicant's argument regarding the new matter seems to have missed the point, in that it referred to the amendment to the figure, instead of claims 28-42 which explicitly added that there was variation in the pitches of the prisms. As explained in the previous office action and not challenged by applicant, the statement that the pitch equals a certain value plus or minus a given amount still refers to a single pitch that can be set to have a spacing within a given range. That is what the nomenclature has always meant by standard drafting practices, and that is also what it means in plan English.

Regarding applicants arguments in response to the rejection under 112, first paragraph, applicant asserts that the guidance to keep the pitch varying within the tolerance range acceptable for the overall pitch tolerance is sufficient for enablement. As applicant has not provided even a single example showing how the pitch is to be varied, or explained what it is to be varied for, those of skill in the art would have no way to set how or where to vary the pitch, in fact they would not know if they achieved the invention of applicants as no goal or example has been presented. If evidence can be provided that shows that it was in fact known in the art to vary the pitch to some end, the enablement rejection could be dropped. However, until that is done the rejection for lack of enablement remains. The new matter rejection, however, would remain even if there were

Art Unit: 2871

other documents that disclose how and why to vary the pitch, as that would not provide evidence that applicant was in fact in possession of the claimed invention.

Allowable Subject Matter

Claims 1-7 are allowable over the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Parker whose telephone number is (703) 305-6202. The fax phone number for this Group is (703) 308-7722. Any inquiry of a

Serial Number: 09/241,949

Page 8

Art Unit: 2871

general nature or relating to the status of this application or preceding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

March 24, 2002


KENNETH ALLEN PARKER
PRIMARY PATENT EXAMINER
GAU 2871